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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 787,613	03 20 2001	Heinz Isak	49458	4678

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Keil & Weinkauff
1101 Connecticut Avenue NW
Washington, DC 20036

EXAMINER

TUCKER, ZACHARY C

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 02/26/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,613

Applicant(s)

ISAK ET AL.

Examiner

Zachary C. Tucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is directed to a process for drying compounds of general formula (I). The word "drying" is a relative term. Claim 1 provides no basis for ascertaining the requisite degree of drying, making it unclear exactly what process applicant is seeking the right to exclude others from performing. Claim 1 has been examined on the merits as though any degree of solvent or water evaporation meets the limitation of "drying."

Claim 1 refers to the temperature at which the drying process is carried out, referring to the "melting point under the reaction conditions used." It is not clear to what reaction the claim is referring. Claim 1 has been examined on the merits as though the aforementioned phrase read "melting point under the drying conditions employed."

Claim 1 specifies the identities of the substituents on the compound of formula (I). Without an equals sign "=" or the word "is" between the variables and the identity of those variables, the claim is indefinite. Claim 1 has been examined on the merits as though there were an equals sign after "X,Y", "m", and "n".

Claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant

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regards as the invention because claims 2-4 depend from claim 1, which is found to be indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,221,762 (Wingert et al).

Wingert et al discloses preparation of E-oxime ethers of phenylglyoxylic esters. Phenoxymethyl benzoic acids (which are optionally substituted) are prepared as an intermediate in the Wingert et al process. Columns 10-12 describe the reaction of phenolate with phthalide in the presence of a solvent (preferably methanol or ethanol). In column 12, lines 40-41, Wingert et al expressly suggests carrying out the reaction between phenolate and phthalide in the melt (above the melting point of reactants and products) at a temperature ranging from preferably 160-220°C and at atmospheric pressure (col.12, lines 50-52).

The deficiencies of the Wingert et al patent are the lack of there being a specific statement to the effect that drying occurs when the phenoxymethylbenzoic acid is formed in the liquid phase at the temperatures suggested and a specific disclosure of the percent by weight solvent content of the phenolate, phthalide, and phenoxymethylbenzoic acid mixture when step (c) is carried out.

However, carrying out the synthesis of phenoxymethylbenzoic acids in the manner suggested by the Wingert et al patent, one would necessarily be causing of the methanol or ethanol present in the reaction milieu to evaporate, thus meeting the claim limitation of "drying" the phenoxymethylbenzoic acids because these compounds are present as a reaction product. Indeed, column 12, lines 35-38 of Wingert et al state that the phenolate and lactone (phthalide) are reacted with simultaneous removal of solvent.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to follow the general procedure for synthesis of phenoxymethylbenzoic acids as suggested in the Wingert et al patent, and in doing so, optimize the amount of methanol or ethanol solvent in the reaction mixture of step (c). The motivation to do so would have been to make a chemical intermediate useful in the synthesis of pharmaceuticals.

Allowable Subject Matter

Claim 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication should be directed to Zachary Tucker whose telephone number is (703) 305-2050. The examiner can normally be reached Monday-Friday from 8:00am to 4:00pm. If Attempts to reach the examiner are unsuccessful, the examiner's supervisor, Gary Geist, can be reached at (703) 308-1701. The fax number for the organization where this application or proceeding is

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assigned is (703) 308-4556 for regular communications and (703) 308-4242 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read "Samuel C. Hahn". The signature is fluid and cursive, with a long horizontal line extending to the right.

- GROUP 1623